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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,541	09/18/2003	Michael J. Porter	2033.66887	5956

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GREER, BURNS & CRAIN
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CHICAGO, IL 60606

EXAMINER

EWALD, MARIA VERONICA

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,541

Applicant(s)

PORTER, MICHAEL J.

Examiner

Maria Veronica D. Ewald

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 9, 11 - 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 9, 11 - 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 – 5, 6 – 9, 11 – 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonda, et al. (U.S. 2,655,978). Gonda, et al. teach an embedment device for use in a structural panel production line wherein a slurry is transported on a moving carrier relative to a support frame and chopped fibers are deposited upon the slurry said device comprising, a first elongate shaft secured to the support frame and having a plurality of axially-spaced disks (figure 19; column 20, lines 30 – 40); a second elongate shaft secured to the support frame and having a second plurality of axially spaced disks (figure 19; column 20, lines 30 – 40); said first shaft being disposed relative to said second shaft so that said disks intermesh with each other (figures 6 and 19). Gonda, et al. further teach that when viewed from the side, peripheries of said first and second pluralities of disks overlap each other (figures 6 and 19). In addition, the shafts are oriented on the frame to be generally transverse to the direction of movement of the slurry along the production line and the shafts are oriented on the frame to be generally parallel to each other and define a plane vertically displaced from and parallel to said moving carrier (column 18, lines 15 – 30; column 20, lines 10 – 20, 43 – 65).

With respect to claims 5 – 8, Gonda, et al. teach that the shafts include relatively smaller diameter spacer disks between adjacent pairs of said first and second plurality of disks, and peripheries of said first and second pluralities of disks are in close proximity to corresponding peripheries of said opposed spacer disks (figure 19); wherein said disks are fixed to said corresponding elongate shafts for common rotation (column 18, lines 15 – 30; column 20, lines 10 – 20, 43 – 65); the first plurality of disks are disposed relative to the frame to create a first trough pattern in the slurry for embedding fibers therein, and the second plurality of disks are disposed relative the frame to create a second trough pattern in the slurry, said second pattern being transversely offset from said first pattern (column 10, lines 25 – 32; column 11, lines 13 – 16); and the shafts are configured to rotate in the same direction (figures 6 and 19; column 18, lines 15 – 3; column 20, lines 10 – 20, 43 – 65).

With respect to claims 9 and 11 – 13, Gonda, et al. teach an embedment device for use in embedding fibers into a settable slurry used in producing a structural board on a board production line including a support frame (column 9, lines 60 – 75), said device comprising: a first elongate support shaft secured to the frame and having a first plurality of relatively large diameter disks stacked axially along said shaft in between a first plurality of relatively small diameter disks (figure 19; column 20, lines 30 – 40); a second elongate support shaft secured to the frame and having a second plurality of relatively large diameter disks stacked axially along said shaft in between a first plurality of relative small diameter disks (figure 19; column 20, lines 30 – 40), said first and second support shafts positioned relative to each other so that said first plurality of

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relatively large diameter disks are intermeshed with said second plurality of relatively large diameter disks; peripheries of said first and second intermeshed pluralities of relatively large diameter disks overlap each other and are in close proximity to corresponding peripheries of said opposed relatively small diameter disks; and said shafts being oriented on the frame to be generally parallel to each other and to define a plane vertically displaced from and parallel to a moving carrier on said frame (figures 6 and 19; column 18, lines 15 – 35, 53 – 70); wherein each said large diameter disks and said small diameter disks have a thickness, and said thicknesses of said large diameter disks and said small diameter disks are approximately the same (figures 6 and 19; column 18, lines 73 – 75); the shafts are oriented on the frame to be generally transverse to the direction of the movement of the slurry along the production line and are generally parallel to each other (figures 6 and 19; column 10, lines 1 – 12 ; column 18, lines 15 – 37); and the disks are fixed to said corresponding elongate shafts for common rotation (column 18, lines 15 – 35; column 20, lines 30 – 45, 50 – 65).

With respect to claim 14, Gonda, et al. teach an embedment device for use in embedding fibers into a settable slurry used in producing a structural board on a board production line including a support frame, said device comprising: a first elongate support shaft secured to the frame and having a first plurality of relatively large diameter disks stacked axially along said shaft in between a first plurality of relatively small diameter disks (figure 19; column 20, lines 30 – 40); a second elongate support shaft secured to the frame and having a second plurality of relatively large diameter disks stacked axially along said shaft in between a first plurality of relative small diameter

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disks (figure 19; column 20, lines 30 – 40), said first and second support shafts positioned relative to each other so that said first plurality of relatively large diameter disks are intermeshed with said second plurality of relatively large diameter disks (figures 6 and 19; column 18, lines 15 – 35, 53 – 70); each of said first plurality of relatively large diameter disks overlapping a corresponding one of said second plurality of relatively large diameter disks approximately the length of a radius of said large diameter disks (figures 6 and 19); peripheries of said first and second pluralities of relatively large diameter disks in close proximity to corresponding peripheries of said opposed relatively small diameter disks (figure 19); said shafts being oriented on the frame to be generally parallel to each other and to define a plane vertically displaced from and parallel to said board production line (figures 6 and 19); said first plurality of relatively large diameter disks being disposed relative to the frame to create a first trough pattern in the slurry for embedding the fibers therein, and said second plurality of relatively large diameter disks being disposed relative to the frame to create a second trough pattern in the slurry, said second trough pattern being transversely offset from said first pattern (column 9, lines 1 – 10; column 10, lines 15 – 20) and said first and second shafts, and said associated disks, rotate in the same direction (column 18, lines 15 – 35, 65 – 70).

Response to Arguments

14. Applicant's arguments with respect to claims 1 – 14 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Webb, et al. fail to show intermeshing large disks when the disks are viewed from the side.

Furthermore, Applicant argues that Fritsch fails to show disks, which are used for "kneading" the slurry. Examiner agrees that Webb, et al. fail to show intermeshing disks and thus, has cited the reference of Gonda, et al. Gonda, et al. teach an apparatus for corrugating laminate material and also embedding such material with resin in water or spirit solution (column 9, lines 1 – 5). Furthermore, the apparatus is comprised of a plurality of shafts on which intermeshing disks are placed for the purpose of imparting a corrugating pattern of crests and bases onto the laminate sheet.

With respect to the intended use recitations in the claims themselves which state "...embedding device for use in a structural panel...wherein a slurry is transported...and chopped fibers are deposited upon the slurry..." intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the

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structural limitation of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235. Thus, Examiner gives weight *not to the material being processed or use of the apparatus*, but the components and structure being claimed.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Veronica D. Ewald whose telephone number is 571-272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MVE


JOSEPH S. DEL SOLE
PRIMARY EXAMINER 11/2/06